

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Lincoln Eramo, Jr.
Application No.:	10/767986
Filed:	January 29, 2004
Patent No.:	7534495
Issue Date:	May 19, 2009
For:	LUBRICIOUS COMPOSITION
Examiner:	Susan W Berman
Group Art Unit:	1796

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Docket No.: S63.2B-11325-US01

**Application for Patent Term Adjustment, 37 CFR 1.705**

The patentee hereby requests reconsideration, under 35 USC 154 (d), of the Determination of Patent Term Adjustment made by the Director as indicated on the Issue Notification and on the face of US 7534495, issued 05/19/2009, copies of which are attached hereto.

As indicated on the face of the patent and on the Issue Notification, the adjustment to patent term is 683 days. Also attached is the PAIR record showing the basis for this determination. The determination is incorrect.

The application was filed after January 29, 2004 and so is entitled to the benefit of the current version of 35 U.S.C. 154. The determination fails to follow the calculation method required by law as determined in *Wyeth v. Dudas*, 88 USPQ2d 1538 (DC DC 2008), currently on appeal to the Federal Circuit, which is controlling law for the issues presented herein.

This Application also constitutes a request that the patent term adjustment be made in accordance with the determination method described herein.

- (1) This request is accompanied by the fee set forth in §37 CFR 1.18(e).

(2) This request is timely filed as it is being filed on 7/20/2009. The patent issued 5/19/2009 and the two month date for petitioning the commissioner fell on a Sunday, 7/19/2009. Under the patent statutes, the patentee is entitled to file this petition on the Monday immediately following the Sunday due date. This request could not have been filed prior to the issuance of the patent as the "three year" delay days could not have been determined until the issuance date. To that end, Petitioner notes that a petition filed by this law firm prior to the issue date, in application 10/037036, was held in abeyance pending issuance of the patent in a decision in which the Office stated:

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being held in abeyance until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

and further:

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

(3) Statement of the facts involved:

(i) The correct patent term adjustment and the basis under 37 CFR § 1.702 for the adjustment is as follows:

USPTO delay days to the issuance of the first Office Action	766
Applicant delay days	-83
Non-overlapping three year days (excluding days subsequent to filing of RCE)	+416
Correct Adjustment	1099

(ii) The relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f) to which the patent is entitled are explained as follows:

The Office calculation of 766 days fails to recognize any "three years" delay days. As *Wyeth* establishes, this is improper. This application was pending for more than three years as of 01/29/2007. No time was consumed by an interference proceeding under 35 U.S.C. 135(a); no time was consumed by the imposition of a secrecy order under 35 U.S.C. 181; by review by the Board of Patent Appeals and Interferences or a Federal court. An RCE was filed 06/23/2008. Applicant is entitled to an additional adjustment to the patent term based on the delay between the three year -date (01/29/2007) and the filing of the RCE (06/23/2008), and adjusted to take into account overlap between the "three years" delay days and the delay beyond 14 months. In this case, the overlap period extended from 01/29/2007 to 05/04/2007.

All delay in the processing of the application by the Office that was requested by the applicant has already been accounted for.

From and including 01/29/2007 through 04/29/2009, the date of issuance, the number of three years days, as adjusted to account for the 06/23/2008 filing of an RCE, was 511 days. Subtracting the overlap of 95 days of USPTO delay falling in this same interval, for which the patent term has already been credited, and the Applicant's delay of 83 days leaves a balance of 333 days, which balance should have been added to the 766 days calculated for the adjustment as of the date of the Determination. Thus the total adjustment that should have been shown on the face of the patent 35 USC 154 (b) was 1099 days.

(iii) The patent is not subject to a terminal disclaimer.

(iv) (A) The applicant does not believe that there are any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704, other than those already accounted for in the applicant delay days noted above.

All items required under 37 CFR 1.705 having been provided herein, the applicant requests that the Patent Term Adjustment be corrected to show an adjustment of 1099 days.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

Date: July 20, 2009

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APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,986	05/19/2009	7534495	S632-11325-US01	5339

490 7550 04/29/2009  
VIDAS, ARRETT & STEINKRAUS, P.A.  
SUITE 400, 6640 SHADY OAK ROAD  
EDEN PRAIRIE, MN 55344

MAY 8 2009

**ISSUE NOTIFICATION**

The projected patent number and issue date are specified above.

**Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)**  
(application filed on or after May 29, 2000)

The Patent Term Adjustment is 683 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (571)-272-4200.

**APPLICANT(s) (Please see PAIR WEB site <http://pair.uspto.gov> for additional applicants):**

Lincoln Eramo, Winchester, CA;

(12) **United States Patent**  
**Eramo**

(10) **Patent No.:** US 7,534,495 B2  
(45) **Date of Patent:** May 19, 2009

(54) **LUBRICIOUS COMPOSITION**

(75) Inventor: Lincoln Eramo, Winchester, CA (US)

(73) Assignee: Boston Scientific Scimed, Inc., Maple Grove, MN (US)

(\*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 683 days.

(21) Appl. No.: 10/767,986

(22) Filed: Jan. 29, 2004

(65) **Prior Publication Data**

US 2005/0170071 A1 Aug. 4, 2005

(51) **Int. Cl.**

B32B 27/08 (2006.01)

C09D 133/14 (2006.01)

(52) **U.S. Cl.** ..... 428/424.2; 428/515; 522/39; 522/44; 522/46; 522/121; 522/142

(58) **Field of Classification Search** ..... 522/84, 522/85, 121, 142, 39, 44, 46; 428/424.2, 428/515

See application file for complete search history.

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Primary Examiner—Susan W Berman

(74) Attorney, Agent, or Firm—Vidas, Arnett & Steinkraus, P.A.

(57) **ABSTRACT**

A lubricious composition suitable for use on medical device, the composition including at least one alkoxylated acrylate compound having at least two acrylate groups per molecule and at least one second component which provides lubricity.

45 Claims, No Drawings

Select New Case	Application Data	Transaction History	Image File Wrapper	Patent Term Adjustments	Fees	Published Documents	Address & Attorney/Agent
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## Patent Term Adjustment

Filing or 371(c) Date:	01-29-2004	USPTO Delay (PTO) Delay (days):	766
Issue Date of Patent:	05-19-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	83
Post-Issue Petitions (days):	+0	Total Patent Term Adjustment (days):	683
USPTO Adjustment (days):	+0	<a href="#">Explanation Of Calculations</a>	i

## Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
04-29-2009	PTA 36 Months		
05-19-2009	Patent Issue Date Used in PTA Calculation		
04-14-2009	Dispatch to FDC		
04-10-2009	Application Is Considered Ready for Issue		
04-09-2009	Issue Fee Payment Verified		
04-09-2009	Issue Fee Payment Received		
01-09-2009	Mail Notice of Allowance		
01-06-2009	Document Verification		
01-06-2009	Notice of Allowance Data Verification Completed		
01-06-2009	Case Docketed to Examiner in GAU		
12-22-2008	Examiner's Amendment Communication		
11-04-2008	Date Forwarded to Examiner		
10-09-2008	Response after Non-Final Action		
07-17-2008	Mail Non-Final Rejection		
07-16-2008	Non-Final Rejection		
06-30-2008	Date Forwarded to Examiner		
06-30-2008	Date Forwarded to Examiner		
06-23-2008	Request for Continued Examination (RCE)	60	
06-30-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		↑
06-23-2008	Request for Extension of Time - Granted		↑
06-23-2008	Workflow - Request for RCE - Begin		↑
04-30-2008	Mail Advisory Action (PTOL - 303)		↑
04-28-2008	Advisory Action (PTOL-303)		↑
04-22-2008	Date Forwarded to Examiner		↑
04-21-2008	Amendment after Final Rejection		↑
01-24-2008	Mail Final Rejection (PTOL - 326)		↑

01-22-2008	Final Rejection	
12-03-2007	Date Forwarded to Examiner	
11-28-2007	Response after Non-Final Action	23
11-15-2007	Mail Notice of Informal or Non-Responsive Amendment	↑
11-10-2007	Date Forwarded to Examiner	↑
11-05-2007	Informal or Non-Responsive Amendment after Examiner Action	↑
11-05-2007	Response after Non-Final Action	↑
11-05-2007	Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received	
10-04-2007	Case Docketed to Examiner in GAU	
08-08-2007	Mail Non-Final Rejection	
08-06-2007	Non-Final Rejection	
05-24-2004	Information Disclosure Statement considered	
06-13-2007	Case Docketed to Examiner in GAU	
06-06-2007	Date Forwarded to Examiner	
06-04-2007	Response to Election / Restriction Filed	
05-04-2007	Mail Restriction Requirement	766
05-02-2007	Requirement for Restriction / Election	↑
08-05-2005	Case Docketed to Examiner in GAU	↑
07-06-2004	IFW TSS Processing by Tech Center Complete	↑
07-06-2004	Case Docketed to Examiner in GAU	↑
05-24-2004	Reference capture on IDS	↑
05-24-2004	Information Disclosure Statement (IDS) Filed	↑
05-24-2004	Information Disclosure Statement (IDS) Filed	↑
06-17-2004	Application Return from OIPE	↑
06-17-2004	Application Return TO OIPE	↑
06-16-2004	Application Return from OIPE	↑
06-17-2004	Application Is Now Complete	↑
06-16-2004	Application Return TO OIPE	↑
06-16-2004	Application Dispatched from OIPE	↑
06-16-2004	Application Is Now Complete	↑
03-11-2004	Cleared by OIPE CSR	↑
02-09-2004	IFW Scan & PACR Auto Security Review	↑
01-29-2004	Initial Exam Team nn	↑